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10/649,624	08/28/2003	Hiroki Yamauchi	2003_1212A	5300
513 7590 06/11/2009 WENDEROTH, LIND & PONACK, L.L.P. 1030 15th Street, N.W., Suite 400 East Washington, DC 20005-1503				
EXAMINER				
OKORONKWO, CHINWENDU C				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/649,624

Applicant(s)

YAMAUCHI ET AL.

Examiner

CHINWENDU C. OKORONKWO

Art Unit

2436

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 61-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 61-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. In response to communications filed on 05/04/2009, the Examiner acknowledges the amendments made to the claims and have both considered and applied them to the claims.

Claims 61-71 are presented for examination.

Response to Remarks/Arguments

2. Applicant's arguments with respect to the rejection of the claims have been fully considered but they are moot in view of the new ground(s) of rejection.

Priority

3. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(a)-(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Priority is claimed from Foreign Application 2002-249215 (Japan).

Information Disclosure Statement

4. For the record, the Examiner acknowledges the IDS submitted on 03/08/2004 and 05/13/2004. They have been received and considered.

Oath/Declaration

5. For the record, the Examiner acknowledges that the Oath/Declaration submitted on 08/28/2003 has been received and considered.

Drawings

6. For the record, the Examiner acknowledges that the Drawings submitted on 08/28/2003 have been received and considered.

Specification

7. For the record, the Examiner acknowledges that the Specification submitted on 11/13/2007 has been received and considered.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 61 and 71 are rejected under 35 U.S.C. 112, second paragraph, as failing to provide sufficient antecedent basis for the limitations of all claims which applicant(s) regard as their invention. Claim 61 and 71 recites the limitation "the predetermined value." There is insufficient antecedent basis for this limitation in the claim.

Claim Objections

9. Claim 61 is objected to because of the following informalities: the claim recites, "a management request indicating one of a duplication request for duplicating a content and a deletion request for deleting the content." The Examiner objects to the claim to

"one of" two elements but the recitation of "[element 1] **and** [element 2]." The claim should read "[element 1] **or** [element 2]," elements 1 and 2 being the duplication request and deletion request respectfully. Appropriate correction is required.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 61-62 and 70-71 are rejected under 35 U.S.C. 102(e) as being disclosed by Enoki et al. (US Patent No. 5,873,085 *hereinafter* "Enoki").

Regarding claim 61, Enoki, discloses a content duplication management apparatus that manages content duplications performed on an apparatus, comprising:

- a request receiving unit (14:58 - "receiving section 107") configured to receive, from the apparatus, a management request indicating one of a duplication request for duplicating a content and a deletion request for deleting the content (29:34-36 – "access request processing section," 29:36-43 – "duplication/deletion management section is provided instead of the duplication management section");

- a management unit (15:67 – 16:3 – “management table processing section 601”) configured to execute the management request received from said request receiving unit in order of arrival (15:67 – 16:3 – “processes the request by using the management table 103, and instructs the transmitting section 108 to transmit the processed result to the client computer 109a. Subsequent to the step S702, the transmitting section 108 transmits the processed result to the client computer 109a (step 703) ... steps S202, S203, and S204 in Fig. 2 described in the first embodiment are performed in sequence.” The Examiner understands the disclosure of these steps being performed “in sequence” (for each received request) to indicate that, as claimed, the requests are processed/handled in the order in which they are received.)
- a holding unit configured to hold duplication restriction information indicating a number of permitted content duplications (28:54—29:48 - “duplication management section 1102 checks the file access table 3106 and determines a frequently accessed file identifier ... when there occurs a file access request from the client computer 3112, the file access table 3106 is updated by the file access count updating section 3107, and the duplication management section 1102 which is activated by the timer 3108 at predetermined intervals ... further when request for the duplication file happens to be made from multiple client computers simultaneously, the access request processing section 3105 processes such requests not only as request to the server where the original file

is stored but also as requests to other servers where copies are stored"), wherein said management unit,

- (1) when the management request that has been received first among the management requests that have not been executed is the deletion request, adds the predetermined value to the number of permitted content duplications (15:45-55 and 29:57-61), and
- (2) when the management request that has been received first is the duplication request and
 - (i) if the number indicated by the duplication restriction information is greater than the predetermined value, duplicates the content for the apparatus, and subtracts the predetermined value from the number indicated by the duplication restriction information (28:46 – 29:6),
 - (ii) if the number indicated by the duplication restriction information is less than the predetermined value, rejects the duplication request (28:46 – 29:6), and
 - (iii) if the number indicated by the duplication restriction information is less than the predetermined value and the deletion request exists subsequent to the duplication request, executes, on an exceptional basis, the deletion request prior to the duplication request, and adds the predetermined value to the number indicated by the duplication restriction information (28:46 – 29:6 and 30:36-44).

Regarding claim 62, Enoki, discloses the content duplication management apparatus of claim 61, wherein said management unit further duplicates the content for the apparatus that has requested the duplication request, and subtracts the predetermined value from the number indicated by the duplication restriction information, after executing the deletion request prior to the duplication request, and adds the predetermined value to the number indicated by the duplication restriction information (15:67 – 16:3).

Claim 70, which claims, a content duplication management method for managing content duplications performed on an apparatus, comprising: a request receiving step of receiving, from the apparatus, a management request indicating one of a duplication request for duplicating a content and a deletion request for deleting the content; a management step of executing the management request received from a request receiving unit in order of arrival; a holding step of holding duplication restriction information indicating a number of permitted content duplications, wherein in the management step, (1) when the management request that has been received first among the management requests that have not been executed is the deletion request, the predetermined value is added to the number of permitted content duplications, and (2) when the management request that has been received first is the duplication request and (i) if the number indicated by the duplication restriction information is greater than

the predetermined value, the content is duplicated for the apparatus, the predetermined value is subtracted from the number indicated by the duplication restriction information, (ii) if the number indicated by the duplication restriction information is less than the predetermined value, the duplication request is rejected, and (iii) if the number indicated by the duplication restriction information is less than the predetermined value and the deletion request exists subsequent to the duplication request, the deletion request is executed on an exceptional basis prior to the duplication request, and the predetermined value is added to the number indicated by the duplication restriction information - Rejected under the same rationale as claims 61 and 62.

Claim 71, which claims, a content duplication management system comprising an apparatus and a content duplication management apparatus that manages content duplications performed on the apparatus connected to a network, said content duplication management apparatus including: a request receiving unit configured to receive, from said apparatus, a management request indicating one of a duplication request for duplicating a content and a deletion request for deleting the content; a management unit configured to execute the management request received from said request receiving unit in order of arrival; a holding unit configured to hold duplication restriction information indicating a number of permitted content duplications, wherein said management unit, (1) when the management request that has been received first among the management

requests that have not been executed is the deletion request, adds the predetermined value to the number of permitted content duplications, and (2) when the management request that has been received first is the duplication request and (i) if the number indicated by the duplication restriction information is greater than the predetermined value, duplicates the content for the apparatus, and subtracts the predetermined value from the number indicated by the duplication restriction information, (ii) if the number indicated by the duplication restriction information is less than the predetermined value, rejects the duplication request, and (iii) if the number indicated by the duplication restriction information is less than the predetermined value and the deletion request exists subsequent to the duplication request, executes, on an exceptional basis, the deletion request prior to the duplication request, and adds the predetermined value to the number indicated by the duplication restriction information – Rejected under the same rationale as claims 61 and 62.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 63-65 and 68-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enoki et al. (US Patent No. 5,873,085 *hereinafter* "Enoki"), in view of Narin et al. (US Patent Application Publication No. 2004/0158709 A1 *hereinafter* "Narin").

Enoki, is silent in disclosing the limitations of claims 63 and 65, however Narin does disclose the duplication restriction information includes an in-group remaining number and an out-group remaining number, and said management unit judges whether or not the apparatus belongs to a predetermined group when the predetermined value is either added to or subtracted from the number indicated by the duplication restriction information, and

(1) if the apparatus is judged to belong to the group, either increases or decreases the in-group remaining number (0065 and 0107), and

(2) if the apparatus is judged to not belong to the group, either increases or decreases the out-group remaining number (0065 and 0107).

It would have been obvious for one of ordinary skill in the art, at the time of the invention to have been motivated to combine the disclosures of Enoki with that of Narin, as both are directed towards virtual file/content management and publishing digital content with a digital rights management system. As such it would have been obvious to combine the two and Narin provide motivation in the recitation, "a need exists ... for providing a digital rights management (DRM) and enforcement architecture and method that allows the controlled rendering or playing of arbitrary forms of digital content ... especially in an office or

organization environment or the like where documents are to be shared amongst a defined group of individuals or classes of individuals (0015).”

Enoki, is silent in disclosing the limitations of claim 64, however Narin does disclose said management unit, (1) when the management request is the duplication request and the apparatus is judged to belong to the group (0092 and 0107), and (i) if the in-group remaining number is not zero, duplicates the content for the apparatus, and subtracts the predetermined number from the in-group remaining number (0065), and (ii) if the in-group remaining number is zero, rejects the management request (0063), and (2) when the management request is the duplication request and the apparatus is judged to not to belong to the group (0092 and 0107), and (i) if the out-group remaining number is not zero, duplicates the content for the apparatus, and subtracts the predetermined number from the out-group remaining number (0065), and (ii) if the out-group remaining number is zero, rejects the management request (0063).

It would have been obvious for one of ordinary skill in the art, at the time of the invention to have been motivated to combine the disclosures of Enoki with that of Narin, as both are directed towards virtual file/content management and publishing digital content with a digital rights management system. As such it would have been obvious to combine the two and Narin provide motivation in the recitation, “a need exists ... for providing a digital rights management (DRM) and enforcement architecture and method that allows the controlled rendering or

playing of arbitrary forms of digital content ... especially in an office or organization environment or the like where documents are to be shared amongst a defined group of individuals or classes of individuals (0015)."

Regarding claim 64, Enoki, is silent in disclosing the limitations of claim 65, however Narin does disclose when the management request is the deletion request, however, and (1) if the apparatus is judged to belong to the group, adds the predetermined value to the in-group remaining number (0065), and (2) if the apparatus is judged not to belong to the group, adds the predetermined value to the out-group remaining number (0065).

It would have been obvious for one of ordinary skill in the art, at the time of the invention to have been motivated to combine the disclosures of Enoki with that of Narin, as both are directed towards virtual file/content management and publishing digital content with a digital rights management system. As such it would have been obvious to combine the two and Narin provide motivation in the recitation, "a need exists ... for providing a digital rights management (DRM) and enforcement architecture and method that allows the controlled rendering or playing of arbitrary forms of digital content ... especially in an office or organization environment or the like where documents are to be shared amongst a defined group of individuals or classes of individuals (0015)."

Enoki, is silent in disclosing the limitations of claim 68, however Narin does disclose content duplication management apparatus wherein said management unit further notifies, to the apparatus, transfer information showing (i) at least a number that is less than the in-group remaining number and (ii) at least a number that is less than the out-group remaining number, and subtracts each of the numbers shown by the transfer information from the in-group remaining number and the out-group remaining number, respectively (0065,0092 and 0107).

It would have been obvious for one of ordinary skill in the art, at the time of the invention to have been motivated to combine the disclosures of Enoki with that of Narin, as both are directed towards virtual file/content management and publishing digital content with a digital rights management system. As such it would have been obvious to combine the two and Narin provide motivation in the recitation, "a need exists ... for providing a digital rights management (DRM) and enforcement architecture and method that allows the controlled rendering or playing of arbitrary forms of digital content ... especially in an office or organization environment or the like where documents are to be shared amongst a defined group of individuals or classes of individuals (0015)."

Regarding claim 69, Enoki, discloses the content duplication management apparatus of Claim 63, wherein said content duplication management apparatus is connected to a network, and further includes an acquisition unit configured to acquire the content from outside a home network, and said management unit

judges that an apparatus connected to the home network belongs to the group, in the judgment of whether or not the apparatus belongs to the group (15:45-55, 15:67-16:3 and 29:57-61).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 66-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enoki (U.S. Patent Application No. 2003/0076955, *hereinafter* "Enoki") in view of Narin et al. (US Patent Application Publication No. 2001/0158709 A1 *hereinafter* "Narin") and further in view of Ganesan (U.S. Patent Application No. 2002/0019814 A1, *hereinafter* "Ganesan").

Regarding claim 66, Enoki, is silent in disclosing the content duplication management apparatus further comprising: an acquisition unit configured to acquire a start time of a processing of the management request; and a time management unit configured to cause said management unit to execute the management request corresponding to the start time, at the start time, however Ganesan does provide such a disclosure (0012 – "a description of the rights

(play, copy, etc.) conferred by the license and related conditions (begin date, expiration date, number of plays, etc.), where such description is in a digitally readable form”).

It would have been obvious for one of ordinary skill in the art to have been motivated to combine the Enoki and Ganesan references as both are directed towards content rights management. The motivation to combine these references is provided by Ganesan, which recites in 0007 “a need exists for a trusted component running on the computing device, where the trusted component enforces the rights of the content owner on such computing device in connection with a piece of digital content, even against attempts by the user of such computing device to access such digital content in ways not permitted by the content owner. As but one example, such a trusted software component prevents a user of the computing device from making a copy of such digital content, except as otherwise allowed for by the content owner thereof”.

Regarding claim 67, Enoki, is silent in disclosing the content duplication management apparatus comprising: an acquisition unit configured to acquire a usage expiry date of the content; and a time management unit configured to cause said management unit to increase the number indicated by the duplication restriction information when the usage expiry date has passed, however

Ganesan does provide such a disclosure (0012 – “a description of the rights (play, copy, etc.) conferred by the license and related conditions (begin date, expiration date, number of plays, etc.), where such description is in a digitally readable form”).

It would have been obvious for one of ordinary skill in the art to have been motivated to combine the Enoki and Ganesan references as both are directed towards content rights management. The motivation to combine these references is provided by Ganesan, which recites in 0007 “a need exists for a trusted component running on the computing device, where the trusted component enforces the rights of the content owner on such computing device in connection with a piece of digital content, even against attempts by the user of such computing device to access such digital content in ways not permitted by the content owner. As but one example, such a trusted software component prevents a user of the computing device from making a copy of such digital content, except as otherwise allowed for by the content owner thereof”.

Conclusion

13. Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to

the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chinwendu C. Okoronkwo whose telephone number is (571) 272 2662. The examiner can normally be reached on MWF 9:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on (571) 272 4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 2436

/C. C. O./

Examiner, Art Unit 2436

/Nasser G Moazzami/

Supervisory Patent Examiner, Art
Unit 2436